

REMARKS

Claims 1, 3-4 and 6-9 are currently pending in the present application. Claims 1, 6, and 7, which were previously amended in response to the Final Office Action, have been amended to reflect clarifications to the invention. Claim 10 has been added. Support for the amendments to claims 1 and 7 can be found at paragraph [0013] of Applicants' published application. Support for claims 6 and 10 can be found at paragraph [0018] of the published application. Claims 2 and 5 remain cancelled.

Applicants have carefully studied the outstanding Office Action. The present Response is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of this application is respectfully requested. Applicants respectfully request reconsideration and withdrawal of the Examiner's rejections in view of the foregoing amendments and following remarks.

Claim Rejections -35 USC § 102

Applicants respectfully traverse Examiner's rejection. Component (b) of Hayakawa does not *require* a polylactone modified hydroxyalkyl (meth)acrylate. In particular, as Examiner notes, Hayakawa recites a range for n that includes the value zero. Further, component (b) of Hayakawa recites that any one or all of i, j, k, m, or n can be zero such that the monomer of formula 1 need *not* be a polycaprolactone. In addition, at column 5, beginning at line 43, Hayakawa recites that even if a lactone is present, example polymer components of its element (b) of its composition could include any one of “ ϵ -caprolactone, β -methyl- δ -valerolactone, χ -valerolactone, δ -valerolactone, α -caprolactone, ϵ -caprolactone, β -propiolactone, or χ -butyrolactone,” which may be used individually or “two or more types can be used in

combination." Applicants submit that nothing in Hayakawa "clearly and unequivocally" directs those skilled in the art to specifically select Applicants' claimed composition containing a (meth) acrylic resin (A) having a hydroxyl group, which is obtained by copolymerizing a mixture having as one of its essential components a polycaprolactone-modified hydroxyalkyl (meth) acrylate *and* further wherein the composition comprises a lactone polyol having three or more hydroxyl groups. As previously submitted by Applicants, a reference must "clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound with any need for picking, choosing, and combining various disclosures..." *In re Arkley*, 455 F.2d 586, 587, 172 U.S.P.Q. 524, 526 (CCPA 1972).

Hayakawa does not identically disclose every element of the claimed invention. See *Corning Glass Works v. Sumitomo Electric*, 9 USPQ 2d 1962, 1965 (Fed. Cir. 1989). A reference that excludes a claimed element, no matter how insubstantial or obvious, is enough to negate anticipation. *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 198 (Fed. Cir. 1983). Even given the argument in the action (which Applicants do not agree with), Hayakawa cannot anticipate the present invention. As stated by the Courts in *Akzo N.V. v. ITC*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986) and *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773, 778 (Fed. Cir. 1985), the anticipating prior art reference "must enable one skilled in the art to practice the claimed invention, thus placing the allegedly disclosed matter in the possession of the public." The mere broad listing of different compounds by Hayakawa does not place a coating composition comprising, for example, a modified polycaprolactone, and the same composition comprising a lactone polyol having three or more hydroxyl groups, in possession of the public. See additionally, *Air Products & Chem. Inc. v. Chas. S. Tanner Co.*, 219 USPQ 223 (D. S.C. 1983) ("a prior art reference which contains a broad general disclosure requiring guessing,

testing, speculation or 'picking and choosing' from an encyclopedic disclosure will not anticipate."). Moreover, nothing would direct those skilled in the art to select a polycaprolactone-modified hydroxyalkyl (meth) acrylate such that the average value of the caprolactone repetitive units is between 2 to 3, as in claim 1. All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994).

As previously submitted, the reference does not provide a sufficient degree of precision with respect to the composition claimed in Applicants' claim 1. When the compound is not specifically named, but instead it is necessary to select portions of teachings within a reference and combine them, e.g., select various substituents from a list of alternatives given for placement at specific sites on a generic chemical formula to arrive at a specific composition, anticipation can only be found if the classes of substituents are sufficiently limited or well delineated. *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). If one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula, the compound is anticipated. One of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula before any of the compounds can be "at once envisaged." One may look to the preferred embodiments to determine which compounds can be anticipated. *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962). However, nothing in Hayakawa recites preferred embodiments of (b) comprising caprolactone repetitive units or a lactone polyol having 3 or more hydroxyl groups.

Furthermore, as Examiner notes, every example of the Hayakawa specification contains a polymer that comprises a monomer of hydroxyethyl methacrylate modified with only one unit of caprolactone. Specifically, the examples of Hayakawa merely state use of Prakcel FM-1, which

is a monomer in which 1 mole of ϵ -caprolactam is added to 2-hydroxyethyl methacrylate. Other examples using 2 or more moles of ϵ -caprolactone are not shown in Hayakawa. Thus, its specification does not enable the modification of more than one unit of caprolactone. To constitute an anticipatory reference, the prior art must contain an enabling disclosure. *Chester v. Miller*, 906 F.2d at 1576 n. 2 (Fed. Cir. 1990); see also *Titanium Metals Corp. of America v. Banner*, 778 F.2d at 781 (Fed. Cir. 1985).

"[B]ecause the hallmark of anticipation is prior invention, the prior art reference-in order to anticipate under 35 U.S.C. § 102-must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.'" *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983). Rather than specifically disclosing a composition having each and every of the limitation of claim 1 in the subject application, Hayakawa discloses combinations of *specific* amounts of each of its compounds *as well as* their combination with other specific elements not claimed in Applicants' independent claim, including, for example, 5-40% of a alkyl etherified melamine resin and from 20-70% of a fluorine containing copolymer comprising the result of copolymerizing at least one fluor-olefin monomer. In order to anticipate, "there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed.Cir. 1991). One skilled in the art would recognize that the resulting performance of a coating will depend profoundly on the chemical nature of the monomers used as well as the amounts incorporated; and therefore, differences would be noted by a person of ordinary skill in the art. In other words, use of the fluorine-containing polymer of component (a) of Hayakawa, the vinyl (co)polymer as recited in (b), the alkyl etherified melamine resin of (c), and the blocked isocyanate compound of

(d) would result in a different function and a different end product.

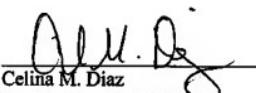
Finally, with respect to amended claim 6 and newly added claim 10, Applicants note that Tables 1 and 2 of Hayakawa show an acid value of a minimum of 5 mgKOH/g. As Applicants clearly state in the last sentence of paragraph [0018] of the application, effects are not able to be obtained if the acid number exceeds 3 mg KOH/g. Thus, the reference fails to anticipate the feature of claims 6 and 10. Consequently, Applicants respectfully request reconsideration and withdrawal of the rejections made to claims 1, 3-4 and 6-10.

CONCLUSION

It is respectfully urged that the subject application is patentable over the references cited by Examiner and is now in condition for allowance. Applicants request consideration of the application and allowance of the claims. If there are any outstanding issues that the Examiner feels may be resolved by way of a telephone conference, the Examiner is cordially invited to contact Colin P. Cahoon or Celina M. Diaz at 972-367-2001.

The Commissioner is hereby authorized to charge any additional payments that may be due for additional claims to Deposit Account 50-0392.

Respectfully submitted,



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Date: September 4, 2009

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